RESPONSE TO OFFICE ACTION OF AUGUST 13, 2008

The Examiner's only rejection is under 35 USC 102 (a), based on the position that Applicant's invention was disclosed September 29, 2003 in a reference referred to as "Motion Furniture" published by Furniture Today. If we assume, *arguendo* that this is an enabling disclosure[1], Section 102 (a) does not support anticipation because the reference refers to Flexsteel's own spring. The reference does not predate Applicant's date of invention, it proves Applicant's date of invention is at least as early as the date of the reference.

The applicable statutory provision states:

"§ 102. Conditions for patentability; novelty and loss of right to patent

A person shall be entitled to a patent unless--

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent; (emphasis added)

The Examiner states, *inter alia*, the Furniture Today disclosure:

"Motion Furniture discusses on pages 3-4 the seat spring assembly by Flexsteel known in the market as DualFlex …" and

"Examiner maintains that the "Motion Furniture" article discloses the Dualflex spring system." (emphasis added)

The critical inquiry in Section 102 (a) is whether the cited art is prior to Applicant's date of invention. By comparison, Section 102 (b) looks to the time span between the date of publication and the filing date, considering the one year "grace period." If a 102 (a) reference is before Applicant's date of invention, then there is anticipation. If the reference is no earlier than the date of invention, then there is no anticipation.

In the abstract, a date of invention looks first to a date of conception and thereafter considers the diligence in reduction to practice, none of which needs to be considered here. This application is owned by Flexsteel Industries, Inc. The reference, according to the Examiner, discloses a structure of Flexsteel. If it is the same, then the date of invention is at least simultaneous to the reference, because Applicant's invention must have been conceived and reduced to practice at least as early as the publication of information about Applicant's

invention. See, e.g. *National Filtering Oil Co. v Arctic Oil Co.* 8 Blatchf 416, 4 Fish Pat Cas 514, 17 F Cas 1215, No 10042 (1871, CCSDNY) (date of invention is date experiment began, under Patent Act in effect in 19th Century) *In re Downs* 18 CCPA 803, 45 F2d 251 (CCPA 1930); *Dick v Lederle Antitoxin Laboratories* 43 F2d 628 (1930, DC NY) (public disclosure establishes date of invention under old Patent Act) *CIVIX-DDI, LLC v Cellco P'ship* 387 F Supp 2d 869 (2005, ND Ill) (corroborating evidence supporting conception and reduction to practice); *Engelhardt v Judd* 54 CCPA 865, 369 F2d 408, 151 USPQ 732 (CCPA 1966) (reduction to practice may be proved regardless of whether patent application constructively reducing same invention to practice is ever filed); *Harper v Zimmermann* 41 F2d 261 (1930, DC Del) (filing date is not conclusive on question of priority of conception and reduction to practice).

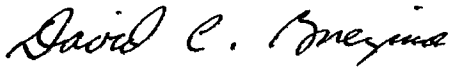
Logically, of course, the publication would not have occurred without some lead time between conception, reduction to practice and description in a publication, but we need not quantify that time span. The fact that the publication can be no earlier than the date of invention completely answers a 102 (a) rejection.

CONCLUSION

Applicant believes that the prior art issues have been conclusively addressed. There being no other issues, claims 1-11 are patentable. Favorable action on the claims is earnestly solicited.

September 23, 2008

Respectfully submitted,



David C. Brezina, Reg. No. 34,128
Barnes & Thornburg LLP
P.O. Box 2786
Chicago, IL 60690
Phone: 312-214-4802
Facsimile: 312-759-5646
Attorney for Applicant

CHDS01 DBREZINA 497957v1

[1] Because the Examiner's position and statements attributing the cited art to Flexsteel provide a complete answer, at this time applicant makes no admission, under US or foreign patent laws or rules, on the sufficiency, authority or adequacy of the disclosure in the Furniture Today reference with respect to any claimed invention.